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09/760,879	01/17/2001	Naohito Takae	1341.1077 (JDH)	4985

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EXAMINER	
FARKONDAR TONSEY, FARIMA	
ART UNIT	**PAPER NUMBER**
2681	

DATE MAILED: 11/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/760,879	TAKAE ET AL.	
	Examiner	Art Unit	
	Farima Farkhondar	2681	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-13 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-13 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2, 5 .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Objections

1. Claims 1, 5,11,13 are objected to because of the following informalities:

Regarding claim 1 on page 31, line 4, "which portable terminal having" is grammatically incorrect. It is suggested to change "which" to "said". Appropriate correction is required.

Regarding claim 5, 1 on page 32, line 18, "which portable terminal having" is grammatically incorrect. It is suggested to change "which" to "said". Appropriate correction is required.

Regarding claim 11, 1 on page 35, line 13, "which portable terminal having" is grammatically incorrect. It is suggested to change "which" to "said". Appropriate correction is required.

Regarding claim 13, 1 on page 36, line 20, "which portable terminal having" is grammatically incorrect. It is suggested to change "which" to "said". Appropriate correction is required.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-3, 5-7, and 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henrick, US Patent 6628940, and in view of Johansson et al., US Patent 5418837 and Hagebarth, US Patent 6484026.

Regarding claim 1, Henrick discloses a portable terminal remote control method of remotely controlling a portable terminal from an external device (column 2, lines 12-18), said portable terminal having a main body provided with a built-in memory (column 2, lines 19-22, note "information storage" reads on "memory" and "cellular telephone terminal" reads on "portable terminal having a main body"). Henrick further discloses the method comprising: a step of accepting a request by said external device related to a change of setting in said portable terminal from a user of said portable terminal (column 2, lines 12-34); and a setting changing "request" sending step of sending a setting changing "request", by said external device to said portable terminal (column 2, lines 19-22). Henrick does not disclose said portable terminal having an attachable/detachable storage medium. Furthermore, Henrick does not disclose that the setting changing mail collectively changes the contents of said built-in memory and

said storage medium of said portable terminal, in response to the received request. However, Johansson discloses said portable terminal having an attachable/detachable storage medium (column 3, lines 18-33, see also Figure 1A – SUM Card 22 with Memory 15'). Johansson further discloses the setting changing "request" collectively changes the contents of said built-in memory and said storage medium of said portable terminal, in response to the received request (for changing the contents of memory see column 7, lines 9-16, furthermore for collective changing of memory and storage medium see column 4, lines 51 to column 5 line 3). Therefore at the time of invention, it would have been obvious to a person of ordinary skill in the art to modify Henrick with the above teachings of Johansson to collectively update memories in order to provide back up data (as suggested by Johansson in column 4, lines 51-58). The combination of Henrick and Johansson does not disclose that the setting changing "request" as set forth above is in form of "mail". However, Hagebarth discloses the "request" is in form of mail (column 5, lines 13-22). Therefore at the time of invention, it would have been obvious to a person of ordinary skill in the art to modify the combination of Henrick and Johansson, with the above teachings of Hagebarth, in order to send the "setting changing request" in form of mail, since e-mails are very well known to the art and easy to use due to their popularity.

Regarding claim 2, see the rejection of claim 1 for the subject matter this claim is dependent upon. The combination of Henrick, Johansson, and Hagebarth further discloses in the setting changing mail sending step, a setting changing mail including a

computer program (Johansson - column 3, lines 40-46) that changes the contents of said built-in memory (Johansson - column 2, lines 29-49) and said storage medium (Johansson - column 4, line 51 to column 5, line 3) and a change of setting identifier is sent (Johansson - column 2, lines 50-57).

Regarding claim 3, see the rejection of claim 1 for the subject matter this claim is dependent upon. The combination of Henrick, Hagebarth, and Johansson discloses the setting changing mail sending step includes a setting changing mail generating step of, upon acceptance of the request related to the change of setting in said portable terminal, generating the setting changing mail containing information suitable to the received request (Henrick - column 3, lines 30-38, and column 3, line 67 to column 4, line 9, note whether the "user selects directory or appointments" reads on "suitable"), the information in the setting changing mail is a computer program (Johansson – column 3, lines 42-46).

Regarding claim 5, Henrick discloses a portable terminal remote control method of remotely controlling a portable terminal (element 105 in figure 1) from an external device (element 101 in figure 1), said portable terminal having a main body provided with a built-in memory (column 2, lines 19-22, note "information storage" reads on "memory" and "cellular telephone terminal" reads on "portable terminal having a main body"). Henrick further discloses the method comprising: a step of receiving a setting changing "request", sent from said external device in said portable terminal (column 6,

lines 8-16). Henrick does not disclose said portable terminal having an attachable/detachable storage medium. Furthermore, Henrick does not disclose that the contents of said built-in memory and said storage medium can be collectively changed; and a first updating step of collectively updating the contents of said built-in memory and said storage medium based on the content of the received setting changing mail. However, Johansson discloses said portable terminal having an attachable/detachable storage medium (column 3, lines 18-33, see also Figure 1A – SUM Card 22 with Memory 15'). Johansson further discloses that the contents of said built-in memory and said storage medium can be collectively changed; and a first updating step of collectively updating the contents of said built-in memory and said storage medium based on the content of the received setting changing "request" (column 4, lines 54-60, note "the backup memory can be arranged for the entire contents of memory 15 reads on "changing the contents of built-in memory and storage medium". See also column 4, line 63 to column 5, line 3). Therefore, at the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the Henrick with the above teachings of Johansson to update both built-in memory and SIM card or IC- circuit, in order to provide backup, as suggested by Johansson (column 4, lines 51-54). The combination of Henrick and Johansson does not disclose the "request" as set forth above is in form of "mail". However, Hagebarth discloses the "request" is in form of e-mail (column 5, lines 13-22). Therefore at the time of invention, it would have been obvious to a person of ordinary skill in the art to modify the combination of Henrick and Johansson, with the above teachings of Hagebarth, in order

to send the "setting changing request" in form of e-mail, since e-mails are very well known to the art and easy to use due to their popularity.

Regarding claim 6, see the rejection of claim 5 for the subject matter this claim is dependent upon. The combination of Henrick, Hagebarth and Johansson disclose in the first updating step, said main body updates the contents of said built-in memory and said storage medium by executing a computer program (Johansson – column 6, lines 33-42, see also column 4, lines 54-58 for updating storage medium) contained in said setting changing "request" (Johansson – Figure 3, blocks 80, 85, 90, 95, 100, and 105. Note the setting changing "request" can be sent via "mail" of Hagebarth as discussed above).

Regarding claim 7, see the rejection of claim 5 for the subject matter this claim is dependent upon. The combination of Henrick, Hagebarth and Johansson disclose said storage medium is composed of an IC card or a subscriber identity module card issued by a communication provider, each provided with a processor and a memory (Johansson – column 1, lines 27-35), so that in the first updating step, said main body having a processor that updates the contents of said built-in memory by executing a computer program (Johansson – column 2, lines 39-40, and column 6, lines 33-42), contained in said setting changing program contained in said setting changing mail (Johansson – Figure 3, blocks 80, 85, 90, 95, 100, and 105, Note the setting changing "program" can be sent via "mail" as taught by Hagebarth), and said IC card or

subscriber identity module card are updated by means of a processor-to-processor communication between the processor in said main body and the processor in said IC card or subscriber identity module card (Johansson - see CPU 10 in the mobile terminal in Figure 1A and CPU 225 in the external memory card "SUM card" in figure 1B, note card 22 in Figure 1A can be changed with card 22' in Figure 1B; also see column 7, lines 52-54).

Regarding claim 10, see the rejection of claim 5 for the subject matter this claim is dependent upon. The combination of Henrick, Hagebarth, and Johansson disclose in the step of receiving a setting changing mail (Henrick - column 6, lines 8-16), a setting changing mail including a computer program that changes the contents of said built-in memory and said storage medium (Johansson - column 4, lines 54-60, note "the backup memory can be arranged for the entire contents of memory 15" reads into "changing the contents of built-in memory and storage medium". See also column 4, line 63 to column 5, line 3. Furthermore, note the program in Johansson's SUM card can be transmitted via "mail" of Hagebarth) and a change of setting identifier is received (Johansson - column 3, lines 64-65); and wherein in the first updating step, if the change of setting identifier is present in a setting changing mail, the contents of said built-in memory and said storage medium are updated collective by executing the computer program contained in the setting changing mail (Johansson - column 2, lines 50-57).

Regarding claim 11, Henrick discloses a portable terminal remote control system having at least one external device (element 101 in figure 1) and at least one portable terminal (element 105 in figure 1) and capable of remotely controlling said portable terminal from said external device (column 2, lines 2-18), said portable terminal having a main body provided with a built-in memory (column 2, lines 19-22, note "information storage" reads on "memory" and "cellular telephone terminal" reads on "portable terminal having a main body"). Henrick further discloses wherein said external device having, an accepting unit which accepts a request related to a change of setting in said portable terminal from a user of said portable terminal (column 3, lines 31-39). Henrick does not disclose the said portable terminal having an attachable/detachable storage medium. Furthermore, Henrick further does not disclose setting changing mail collectively changes the contents of said built-in memory and said storage medium of said portable terminal, in response to the received request. However, Johansson discloses said portable terminal an attachable/detachable storage medium (column 3, lines 18-33, see also Figure 1A – SUM Card 22 with Memory 15'). Johansson further discloses a setting changing "request" collectively changes the contents of said built-in memory and said storage medium of said portable terminal, in response to the received request (for changing the contents of memory see column 7, lines 9-16, furthermore for collective changing of memory and storage medium see column 4, lines 49 to column 5 line 3). Therefore at the time of invention, it would have been obvious to a person of ordinary skill in the art to modify Henrick with the above teachings of Johansson to collectively update memories in order to provide back up data as suggested by Johansson (column

4, lines 51-58). The combination of Henrick and Johansson does not disclose the "request" as set forth above is in form of mail and a setting changing mail sending unit which sends a setting changing mail, to said portable terminal. However, Hagebarth discloses the "request" as set forth above is in form of mail (column 5, lines 13-22) and a setting changing mail sending unit which sends a setting changing mail, to said portable terminal (column 5, lines 13-19, note it is inherent that a mail sending unit is present for "performance parameters e-mail to be sent). Therefore, at the time of invention, it would have been obvious to a person skilled in the art to modify the combination of Henrick and Johansson with the above teachings of Hagebarth, in order to also include e-mail as another form of transmission in since e-mails are easy to use and very well known to the art.

Regarding claim 12, Henrick discloses a computer-readable recording medium (element 101, Figure 1), in which a portable terminal remote control program is recorded for allowing an external device to remotely control a portable terminal (column 2, lines 12-18) composed of a main body provided with a built-in memory (column 2, lines 19-22, note "information storage" reads on "memory" and "cellular telephone terminal" reads on "portable terminal having a main body"). Henrick further discloses the method comprising: a step of accepting a request by said external device related to a change of setting in said portable terminal from a user of said portable terminal (column 2, lines 12-34), characterized by recording a portable terminal remote control program to have a computer carry out: a step of accepting a request by said external device related to a

change of setting in said portable terminal from a user of said portable terminal (column 2, lines 12-34); and a setting changing "request" sending step of sending a setting changing "request", by said external device to said portable terminal (column 2, lines 19-22). Henrick does not disclose said portable terminal having an attachable/detachable storage medium. Furthermore, Henrick does not disclose that the setting changing mail collectively changes the contents of said built-in memory and said storage medium of said portable terminal, in response to the received request. However, Johansson discloses an attachable/detachable storage medium (column 3, lines 18-33, see also Figure 1A – SUM Card 22 with Memory 15'). Johansson further discloses the setting changing "request" collectively changes the contents of said built-in memory and said storage medium of said portable terminal, in response to the received request (for changing the contents of memory see column 7, lines 9-16, furthermore for collective changing of memory and storage medium see column 4, lines 49 to column 5 line 3). Therefore at the time of invention, it would have been obvious to a person of ordinary skill in the art to modify Henrick with the above teachings of Johansson, to collectively update memories in order to provide back up data as suggested by Johansson (column 4, lines 51-58). The combination of Henrick and Johansson does not disclose that the setting changing "request" as set forth above is in form of e-mail. However, Hagebarth discloses the "request" is in form of e-mail (column 5, lines 13-22). Therefore at the time of invention, it would have been obvious to a person of ordinary skill in the art to modify the combination of Henrick and Johansson, with the above

teachings of Hagebarth, in order to send the "request" in form of e-mail, since e-mails are very well known to the art and easy to use due to their popularity.

Regarding claim 13, Henrick discloses a portable terminal remote control system having at least one external device (Figure 1, element 101) and at least one portable terminal (Figure 1, element 105) and capable of remotely controlling said portable terminal from said external device (column 2, lines 19-22), said portable terminal having a main body provided with a built-in memory (column 2, lines 19-22, note "information storage" reads on "memory" and "cellular telephone terminal" reads on "portable terminal having a main body"). Henrick further discloses wherein said portable device having, a setting changing "request" receiving unit which receives a setting changing "request" sent from said external device (column 3, lines 63-67). Henrick does not disclose said portable terminal having an attachable/detachable storage medium. Furthermore, Henrick does not disclose the setting changing mail by which contents of said built-in memory and said storage medium can be collectively changed. However, Johansson discloses said portable terminal having an attachable/detachable storage medium (column 3, lines 18-33, see also Figure 1A – SUM Card 22 with Memory 15'). Johansson further discloses the setting changing "request" by which contents of said built-in memory and said storage medium can be collectively changed (for changing the contents of memory see column 7, lines 9-16, furthermore for collective changing of memory and storage medium see column 4, lines 49 to column 5 line 3); and an updating unit which collectively updates the contents of said built-in memory and said storage medium

based on the content of the received setting changing mail (column 6, lines 29-37). Therefore at the time of invention, it would have been obvious to a person of ordinary skill in the art to modify Henrick with the above teachings of Johansson to collectively update memories in order to provide back up data as suggested by Johansson in column 4, lines 51-58). The combination of Henrick and Johansson does not disclose that the setting changing "request" as set forth above is in form of "mail". However, Hagebarth discloses the setting changing "request" is in form of "mail" (column 5, lines 13-19). Therefore at the time of invention, it would have been obvious to a person of ordinary skill in the art to modify the combination of Henrick and Johansson, with the above teachings of Hagebarth, in order to send the "request" in form of mail, since e-mails are very well known to the art and easy to use due to their popularity.

4. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Henrick, US Patent 6628940, and in view of Johansson et al., US Patent 5418837 and Hagebarth, US Patent 6484026, and further in view of Moles et al., US Patent 6615038.

Regarding claim 4, see the rejection of claim 3 for the subject matter this claim is dependent upon. The combination of Henrick, Hagebarth and Johansson does not disclose an authenticating step of, upon acceptance of the request related to the change of setting in said portable terminal from the user of said portable terminal, checking whether the user is an authorized user or not, and generating the setting changing mail only when the user is an authorized user. However, Moles discloses an

authenticating step of, upon acceptance of the request related to the change of setting in said portable terminal from the user of said portable terminal, checking whether the user is an authorized user or not, and generating the setting changing mail only when the user is an authorized user (column 8, lines 49-65). Therefore at the time of invention it would have been obvious to a person skilled in the art to modify the combination of Henrick, Johansson, and Hagebarth with the above teachings of Moles, in order to authorize the subscriber (as suggested by Moles in column 8, line 63-66).

5. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Henrick, US Patent 6628940, and in view of Johansson et al., US Patent 5418837 and Hagebarth, US Patent 6484026, and further in view of Svensson, US Patent 5687216.

Regarding claim 8, see the rejection of claim 5 for the subject matter this claim is dependent upon. The combination of Henrick, Johansson, and Hagebarth disclose a first storing step of storing the received setting changing mail in said internal memory (Johansson - column 2, lines 29-41); The combination of Henrick, Hagebarth, and Johansson does not disclose a second updating step of, when said storage medium is replaced with another storage medium, updating the contents of said another storage medium by running the computer program contained in the setting changing mail stored in said internal memory. However, Svensson discloses a second updating step of, when said storage medium is replaced with another storage medium, updating the contents of said another storage medium by running the computer program (column 2,

lines 46-55) contained in the setting changing mail stored in said internal memory (as already discussed in this claim). Therefore, at the time of invention it would have been obvious to a person of ordinary skill in the art to add the above teachings of Svensson, to the combination of Henrick, Johansson, and Hagebarth, to transport information to another phone as suggested by Svensson (column 4, line 14-17).

6. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Henrick, US Patent 6628940, and in view of Johansson et al., US Patent 5418837 and Hagebarth, US Patent 6484026, and further in view of Hubbe et al., US patent 6278885.

Regarding claim 9, see the rejection of claim 5 for the subject matter this claim is dependent upon. The combination of Henrick, Johansson, and Hagebarth disclose a first storing step of storing the received setting changing mail in said storage medium (Johansson- column 2, lines 29-41, also see column 4,line 54 to column 5, line 3 for storage in external memory). The combination of Henrick, Johansson, and Hagebarth does not disclose a third updating step of, when said storage medium is inserted into a main body of an another portable terminal, updating the contents in an internal memory of said main body of an another portable terminal by running the computer program contained in the setting changing mail stored in said storage medium. However, Hubbe discloses a third updating step of, when said storage medium is inserted into a main body of an another portable terminal, updating the contents in an internal memory of said main body of an another portable terminal by running the computer program

(abstract, see also column 3, lines 26-35) contained in the setting changing mail stored in said storage medium (as already discussed in this claim). Therefore, at the time of invention it would have been obvious to a person of ordinary skill in the art to add the above teachings of Hubbe to the combination of Henrick, Johansson, and Hagebarth, to enable a mobile user to for example store the directory information in his SIM card to the internal memory of another mobile when the user is using another phone (as suggested by Hubbe, column 4, lines 8-14).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

US Patent 6351639, Motohashi, Telephone Whose Setting Details can Be Changed, and Telephone Capable of Changing Settings of Called Telephone. A portable cellular phone with function setting request receiving means for receiving from the calling telephone a function setting request added to call setting information, setting changing means capable of changing setting details according to the function setting request received by the function setting request receiving means.

US Publication 2001/0055964, Karhu, System for Remotely Accessing Data Stored in a Radiotelephone. Remote accessing of data stored in the memory of a radiotelephone.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Farima Farkhondar whose telephone number is 703-305-6285. The examiner can normally be reached on 8:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh Tran can be reached on 703-305-4040. The fax phone numbers for the organization where this application or proceeding is 703-872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the customer service whose telephone number is 703-306-0377.

Farima Farkhondar-Tonsey
Examiner
November 13, 2003

NGUYEN T. VO
PRIMARY EXAMINER